

01/5/11

Attorney Docket No.: 20750-0007US1 / 034.US5.PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Robert M. Jones et al. Art Unit : 1624
Serial No. : 10/541,657 Examiner : Noble E. Jarrell
Filed : March 3, 2006 Conf. No. : 4098
Title : 1,2,3-TRISUBSTITUTED ARYL AND HETEROARYL DERIVATIVES AS MODULATORS OF METABOLISM AND THE PROPHYLAXIS AND TREATMENT OF DISORDERS RELATED THEREETO SUCH AS DIABETES AND HYPERGLYCEMIA

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REFUND

Applicant requests a refund of the fees charged on November 15, 2010 in respect of the "Provisional Notice of Appeal" filed by Applicants on November 15, 2010.

When the "Provisional Notice of Appeal" was filed, Applicants were awaiting a Decision on a Petition Applicants filed on August 13, 2010, which requested, *inter alia*, that finality of the Office Action dated May 13, 2010 be withdrawn. Applicants were orally informed that a Decision issued on November 12, 2010 vacated the finality of the Office Action, but by November 15, 2010 (which would have been the final deadline for responding to the final Office Action dated November 13, 2010 had finality not been withdrawn), no copy of the Petition Decision was available to Applicants through PAIR. Applicants therefore filed the paper titled Provisional Notice of Appeal to preserve their rights in the application, in case finality of the Office Action dated May 13, 2010 had not been withdrawn. That paper stated, in relevant part:

If the present application remains under final rejection pursuant to the Office Action dated May 13, 2010, and a response to that Office Action remains due, Applicants hereby appeal to the Board of Patent Appeals and Interferences from the rejection of claims 1-3, 12-14, 16-61, 73, 74 and 78 and request a three month extension of time under 37 CFR §1.136.

Applicants understand, however, that no response from Applicants is currently due as a result of a Decision on Applicants' Petition dated August 13, 2010 withdrawing the finality of the Office Action dated May 13, 2010 and entering Applicants' Amendment which was filed on August 13, 2010.

Since Applicants have not yet had the opportunity to review the Petition Decision to confirm that the finality of the Office Action has been withdrawn and the Amendment has been entered, Applicants are filing the present Provisional

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Notice of Appeal to preserve Applicants' rights and to confirm Applicants' intent to maintain the present application.

If the finality of the Office Action dated May 13, 2010 has been withdrawn and Applicants' Amendment of August 13, 2010 has been entered pursuant to the Petition Decision, as indicated in the interview, Applicants understand that no further response from Applicants and no fees are currently due.

The Office is authorized, however, to apply any charges or credits that are due, including any fee that may be required for a Notice of Appeal and Extension of Time, to Deposit Account No. 06-1050.

Despite the fact that the "Provisional Notice of Appeal" indicated that it was to be considered an actual Notice of Appeal only if the application remained under final rejection, Applicants were charged fees of \$1110 and \$540 (i.e. a total of \$1650) for the filing of the paper. It appears that the fees correspond to the fees which would have been payable for a 3 month Extension of Time and Notice of Appeal if a 3 month Extension of Time and Notice of Appeal had been needed. At the time the paper was filed and the fee was charged to Applicants, the application was not under final rejection due to the Petition Decision of November 12, 2010 which stated:

The finality of the Office action mailed 13 May 2010 has been withdrawn.

The amendment filed on 13 August 2010 will be entered.

"The Director may refund any fee paid by mistake or in excess of that required." 37 C.F.R. § 1.26. Applicants request a refund of the \$1650 in fees the Office charged in respect of the "Provisional Notice of Appeal" filed on November 15, 2010. The fees were charged in mistake and were "in excess of that required."

The Notice of Appeal fee of \$540 was charged by mistake and was in excess of that required. The "Provisional Notice of Appeal" filed by Applicants made clear that it was to be considered a Notice of Appeal only "[i]f the present application remains under final rejection" because the application did not remain under final rejection because the Director, in the Petition Decision dated November 12, 2010 had vacated the finality of the Office Action dated May 13, 2010 and entered Applicants response filed on August 13, 2010. Moreover, since the finality of the Office Action had been withdrawn, and no response was due, the filing of a Notice of Appeal

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would not even have been proper because an Appeal Brief may only be filed within the time period set in 37 C.F.R. § 1.134 for reply to an Office Action. 37 C.F.R. § 41.31.

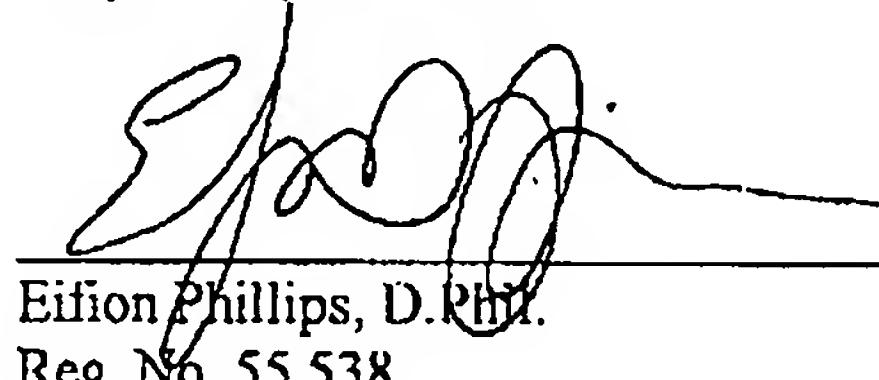
Finally, the Extension of Time fee of \$1110 was also charged by mistake and in excess of that required. Since the Petition Decision directed that finality of the Office Action dated May 13, 2010 be vacated and that Applicants' response filed August 13, 2010 be entered, the requirement that Applicants respond to the Office Action dated May 13, 2010 had been satisfied. Thus, there was no need for any Extension of Time.

Applicants therefore request a refund of the \$1650 in fees the Office charged in respect of the "Provisional Notice of Appeal" filed on November 15, 2010.

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: January 5, 2011


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